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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,832	10/29/2003	Satoshi Shahana	SIC-03-041	2831
29863	7590	08/09/2005	EXAMINER	
DELAND LAW OFFICE P.O. BOX 69 KLAMATH RIVER, CA 96050-0069			JOHNSON, VICKY A	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,832

Applicant(s)

SHAHANA ET AL.

Examiner

Vicky A. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/29/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7, 9-11, 13-21, and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsu (US 5,498,211).

Hsu discloses a derailleur adapted to be mounted to a bicycle frame, wherein the derailleur comprises: a mounting member (302) adapted to be mounted to the bicycle frame; a base member (305) pivotably mounted relative to the mounting member; a biasing mechanism (304) that biases the base member clockwise relative to the mounting member when viewed laterally outwardly from the base member; a chain guide (103); a coupling mechanism (100) coupled between the base member and the chain guide so that the chain guide moves relative to the base member; and a rotation restricting mechanism (303,302, 305b) disposed in a force communicating path between the mounting member and the base member to restrict counterclockwise rotation of the base member relative to the mounting member (col. 2 lines 58-65).

Re claims 2 and 3 the mounting member is structured to be mounted to a rear wheel hub axle (see Fig 3).

Re claim 4, the rotation restricting mechanism comprises a resilient shock absorber (Webster's Dictionary 10th Edition defines resilient to be "capable of withstanding shock without permanent deformation or rupture").

Re claim 5, the rotation restricting mechanism comprises: a first rotation restricting component (305b); and a second rotation restricting component (303); wherein the first rotation restricting component engages the second rotation restricting component to restrict counterclockwise rotation of the base member relative to the mounting member (col. 2 lines 58-65).

Re claim 9, the first rotation restricting component is disposed on the base member (see Fig 3), wherein the mounting member comprises a stopper plate comprising: a first protrusion (300b) adapted to engage the bicycle frame to set a rotational position of the stopper plate relative to the bicycle frame; and a second protrusion (301a)) adapted to engage a first protrusion on the base member to set a rotational position of the stopper plate relative to the base member; and wherein the second rotation restricting component is disposed on the stopper plate (see Fig3).

Re claim 10, wherein the first rotation restricting component comprises a second protrusion disposed on the base member (see Fig 3), and wherein the second rotation restricting component comprises a third protrusion disposed on the stopper plate that engages the second protrusion on the base member (see Fig 3).

Re claim 20, the second rotation restricting component (303) further comprises a guide (inside surface) that forms an interior space (see Fig 3), and wherein the adjusting member (307) is disposed in the interior space (see Fig 3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 12, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu (US 5,498,211) in view of Ichida (US 5,931,753).

Hsu discloses a derailleur as described above, but does not disclose the shock absorber comprising an elastic member.

Ichida teaches the use of a shock absorber comprising an elastic member (col. 3 lines 15-30).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the derailleur of Hsu to include an elastic member as taught by Ichida in order to decrease wear.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of copending Application No. 10/605832. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variants in the breath and scope of the claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

2003/0083162 Tsai et al (shock absorber)


6,793,598 Savard (shock absorber)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vicky A. Johnson whose telephone number is (571) 272-7106. The examiner can normally be reached on Monday-Friday (7:00a-3:30p).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Bucci can be reached on (571) 272-7099. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Vicky A. Johnson 8/5/05
Examiner
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